



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,089	07/10/2001	Rick Rowe	IGTECH.0018P	1158
22434	7590	06/15/2004	EXAMINER	
BEYER WEAVER & THOMAS LLP			SAGER, MARK ALAN	
P.O. BOX 778			ART UNIT	
BERKELEY, CA 94704-0778			PAPER NUMBER	
			3714	
DATE MAILED: 06/15/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/903,089

Applicant(s)

ROWE ET AL.

Examiner

M. A. Sager

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 10-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 10-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Election/Restrictions***

1. With regards to the restriction requirement as cited in prior action, no explicit affirmation of election was made; however, the cancellation of claims directed to non-elected invention, amending of claims and associated remarks therein is deemed at least an implicit affirmation. Further, Applicant filed no remarks alleging the restriction was improper. The requirement is still deemed proper and is now deemed FINAL.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 17 recites the limitation "said receipt validation station" in line 2, but depends from claim 15 that does not claim a validation station. There is insufficient antecedent basis for this limitation in the claim.

4. This is not an objection or rejection and does not form any part of holdings to claims and is provided only with respect to claim construction/interpretation. The phrases 'in the form of' (clm 1, 15, 19) and 'form of' (clm 10) is interpreted as broadening descriptor tangible medium; however, the manner of such broadening is not clear from instant specification or in consideration that it is known in art that electronic representation of data on media (card, disk) is equivalent to paper/plastic media having written data. So although language is not deemed vague or indefinite, the extent of broadening of tangible medium is not interpreted beyond those forms. Also, the 'reward information' being transmitted is deemed the data the host arranged to transmit 'award information' (clm 10, lines 9 and 11-12). Finally, receipt, as now claimed, is tangible in form, and includes either printing a comp point level or amount or a prize for redemption.

***Claim Rejections - 35 USC § 102***

5. Claim 15-16, 18-20 is rejected under 35 U.S.C. 102(b) as being anticipated by Kelly ('918). Where reward, bonus award and award are of value and are not independent of outcome of play at least due to not so claimed, Kelly discloses a method or system of a prize redemption system for games (5:49-34:59) teaching providing at least one gaming machine (12), accepting a wager (7:18-39, 21:59-22:2), arranged to present at least one game (272, 273) and print a receipt associated with an award based upon players play (22, 20), awarding a reward if said player receives a winning outcome (8:38-9:33, 26:44-51), generating game play data associated with players play of gaming machine (7:19-39, 8:20-31), transmitting game play data to a remote device, determining if said player is entitled to a bonus award based upon game play data, transmitting bonus award information to a gaming machine, and issuing a receipt in the form of a tangible medium to said player representative of said bonus award from said gaming machine (10:26-52, 11:12-29, 12:13-22, 15:36-65, 23:65-26:57, figs 1-8, & incorporation by reference cited), accepting said receipt at a remote location and providing said bonus award (9:50-63, 11:24-34, [per 5292127, see ref. 24]), including at least one validation station (sic), and further generating receipt information associated with a bonus award at remote device (9:42-12:22).

***Claim Rejections - 35 USC § 103***

6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly in view of Burns (6048269). Kelly discloses a method or system teaching claimed steps/features (supra) except transmitting information regarding said receipt from receipt validation station to said remote device for validating said receipt. Validating receipts remote from a server/host device is common security protocol to ensure no fraud receipts are redeemed. Burns discloses a system

Art Unit: 3714

and method teaching transmitting information regarding said receipt from receipt validation station to said remote device for validating said receipt (6:30-39, 7:5-38, 7:61-67) to ensure receipt is valid such as already paid, where the receipt is a printed ticket with code information or electronic data encoded on card. Therefore, it would have been obvious to an artisan at a time prior to the invention to add transmitting information regarding said receipt from receipt validation station to said remote device for validating said receipt as a common security protocol as taught by Burns to Kelly to ensure receipt is valid such as paid status.

7. Claim 1-3, 5 is rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sarbin (5179517). Instant specification describes that a tangible medium is 'in the form of' a voucher, ticket or the like or a magnetic stripe card or the like (page 8-9, paragraphs 20-21 or page 14, paragraph 35). Thus, with broadest interpretation of claim invention, Sarbin discloses a method or system of a game machine data transfer system utilizing portable data units comprising generating data regarding a player's activity associated with play of said machine (6:48-7:27), determining if player is entitled to an award based upon the play activity data independent of the direct outcome of a game comprising comparing said transmitted play activity data to predetermined criteria for awarding an award (6:48-7:27, 8:6-13), generating a receipt in the form of a tangible medium for said player at said gaming machine further comprising the printing [electronic such as magnetic stripe on card] of said receipt and issuance of said receipt to said player (6:48-7:21, 8:6-13, refs. 20, 102) for redemption by said player for said award at a location remote from said gaming machine (7:28-54), and transmitting said play activity data to a remote device (refs. 40, 84) [no connectivity is claimed between gaming machine and remote device, only a transmission of play

Art Unit: 3714

data to remote device]. Alternatively, Office is taking Official Notice that writing data electronically to a tangible medium such as a magnetic stripe or smart card is known obvious equivalent to printing data to a tangible medium such as paper or plastic card. Thus, Sarbin's writing data electronically to card is obvious equivalent receipt to claimed generating/printing receipt at least due to same functional purpose of representing entitlement to bonus award or representing bonus level or similar on tangible medium for redemption based upon play activity that is independent of direct outcome of game. Further, alternatively, it is noted that Sarbin's receipt is equivalent to claimed invention for generating a receipt in form of producing a value or number of points representing players play activity independent of gaming outcome for a game or games for redemption for a prize such as a free game. The difference between these steps/features and that which is clearly taught by Sarbin lie in the form of receipt issued. As these features/steps are variations of issuing receipts as are known, such would have been obvious to one of ordinary skill in the art in implementation of Sarbin. Absent criticality, specific form of receipt falls within the realm of choice by game designers, when implementing a particular form of receipt onto Sarbin. The lack of criticality of the specific recitations in the claims is evidenced by Applicant's instant disclosure that further teaches these variations to be equivalent choices. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add 'print a receipt' as an equivalent form of receipt to Sarbin method/system in order to encourage the issue a tangible form of play activity for redemption.

8. Claim 1-5, 10-16, 18-20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Acres ('882) in view of Raven (5429361) or Kelly ('918). Acres discloses a method or apparatus [system] for crediting play activity of a player of an electronic gaming device in a gaming system

Art Unit: 3714

teaching all claimed steps/features including at least one gaming machine adapted to accept credit/wager to present a game and pay a winning in the event a winning event is achieved by play of the game (7:16-25, fig. 1), at least one host (18, 28, 32) with which at least one gaming machine is associated arranged to receive play information regarding player play of machine to determine if an award should be issued for play independent of a winning outcome (8:43-61, 11:21-39, 18:41-20:37, 21:65-23:13, 25:20-28:40, 29:1-32), transmitting award information to gaming machine (26:63-66, 28:6-40) and a receipt generator located at gaming machine for issuing a receipt associated with said award in response to reward information being transmitted to gaming machine from at least one host (sic), generating data regarding player's activity (sic), determining if player is entitled to an award... independent of the direct outcome of a specific game or games (sic), generating a receipt at gaming machine for redemption by player for award (sic) wherein the player's play produces points based on play according to one or more predetermined levels for cashing-in, i.e. redeeming, the accumulated points for comp prizes such as free games, dinner or show. However, Acres fails to provide a receipt as a tangible medium such as a comp/value data on paper ticket/voucher or electronic data on magnetic swipe/smart card since Acres displays play activity level or comp level (sic) and uses a card for player tracking as only an identification device to associate a player number with an account (33:47-63). However, providing a receipt of prize or comp award or level as data on a ticket or on a card was well known prior to instant invention for providing a redeemable tangible medium at gaming machine for remote redemption for player convenience so the player receives a tangible for redemption. Raven discloses dispensing bonus tickets for certain levels of play that may be redeemed in the casino (e.g. cashier) for prizes or player rating level being on a card (9:61-68).

Art Unit: 3714

Kelly also discloses dispensing bonus tickets or data on cards for redeeming (*supra*). Finally, it is noted providing a receipt that reflects either play activity based on performance or based on activity level of play are equivalent for monitoring players play to achieving a goal and providing an award for redemption as a result. The award based upon performance goal is play activity based upon a game goal; while, an award based on player tracking such as amount wagered over time is based on a compensation goal to reward player so as to entice them to continue to play or patron the gaming establishment that is issuing the award. Therefore, it would have been obvious to an artisan at a time prior to the invention to add tangible medium as known as taught by either Raven or Kelly to Acres method or system for player convenience so the player may receive a tangible to show prize award level for redemption. Some players prefer receiving a tangible award to redeem as it provides a psychological connection to reaching a goal, thus providing a receipt as a tangible medium increases their enjoyment of system. Further, providing validation that a receipt is valid is notoriously well known so as to have been conventional at time prior to invention in gaming such as lottery or redemption systems such as Kelly for adding security to protect against fraud. Validation includes validating data on receipt that it was not previously paid or that data on receipt matches data stored in system. Thus it would have been obvious to add receipt validation station, as claimed, as notoriously well known or taught by Kelly to Acres' method or system to increase security to protect against fraud.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Acres in view of Raven or Kelly as applied to claims above, and further in view of Burns (6048269). Acres in view of either Raven or Kelly discloses a method in a system comprising claimed steps/features (*supra*) except transmitting information regarding said receipt from said receipt validation station



Art Unit: 3714

to said remote device for validating said receipt. Validating receipts remote from a server/host device is common security protocol to ensure no fraud receipts are redeemed. Burns discloses a system and method teaching transmitting information regarding said receipt from receipt validation station to said remote device for validating said receipt (6:30-39, 7:5-38, 7:61-67) to ensure receipt is valid such as already paid, where the receipt is a printed ticket with code information or electronic data encoded on card. Therefore, it would have been obvious to an artisan at a time prior to the invention to add transmitting information regarding said receipt from receipt validation station to said remote device for validating said receipt as a common security protocol as taught by Burns to Acres method or system in view of Raven or Kelly to ensure receipt is valid such as to its paid status.

### ***Response to Arguments***

Applicant's arguments with respect to claim 1-5, 10-20 have been considered but are moot in view of the new ground(s) of rejection. First, examiner acknowledges that receipt as defined within Webster's II New Riverside University Dictionary includes the definition 'written acknowledgment that a specified article, sum of money or delivery of merchandise has been received [note: past tense]; however, it does not include the bracketed definitions as included by Applicant. Applicant may be his own lexicographer; however, in this instance, Applicant did not provide such specific definition (as including bracketed data). There is a distinct and subtle difference between receipt meaning definition as within cited Dictionary and 'will be received' which is asserted by Applicant as being included within definition of receipt. Similarly, sum of money and delivery of merchandise is also not 'service'. Applicant failed to be their own lexicographer so as to provide such definition within instant specification, Office has considered

Art Unit: 3714

such definition herein only for purposes of examination, but is not agreeing to such definition as submitted by Applicant since no such definition was provided in filed specification. However, the instant specification, as filed, appears to include redemption of a tangible medium at a validation station remote from a gaming machine, and examination based upon invention as claimed is as above herein. Also, the claimed receipt (clms 1-5, 15-20) is redeemed at a remote location which is interpreted to mean that claimed tangible medium is provided at gaming machine but redeemed at a redemption station/device for validation and redemption of the receipt comp point(s) or value which redemption may be handled manually by personnel or automated by device.

Further, Applicant asserts that claimed invention is not taught or suggested in part (this is a general observation) due to a player needing to proceed to a remote station if they desire to retrieve their comp, but this is similarly required within Applicants system in that a receipt has printed data of a award/bonus/prize [value or comp award (level or point)] which must be taken to a redemption [claimed as validation] station for redemption. The asserted difference in Applicants invention being the providing/generating a tangible medium at gaming machine prior to going to redemption station but yet a player must proceed to a remote station if they desire to retrieve their comp. Thus, Applicants remark is not well taken at least due to instant invention still requires player to proceed to remote location to retrieve comp at least since the receipt is NOT the comp, but merely a tangible medium recording prize/bonus level or award.

Not applicable to any current holding and is provided as informational only. Acres ('852) includes redemption remote from gaming machine at least due to its admission of prior art for such remote redemption of comp awards (1:31-50) and its incorporation by reference of '882

Art Unit: 3714

for all purposes (1:15-20), thus Applicants statement does not consider art as whole with regard to remote redemption or remote retrieval of comp.

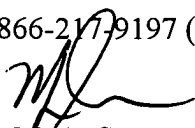
Hogan is noted as evidence only for his admission as prior art at least of time of his filing that at certain casinos offering players club cards, "tickets" are issued based upon the gross wagers made during the time the player plays the slot machine (e.g., one ticket whenever the accumulative wager equals \$50) thereby also showing as evidence of providing a receipt in a tangible form for player based on play activity at gaming machine independent of direct outcome of game play. This is believed to be a reference to Raven's system.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 703-308-0785. The examiner can normally be reached on T-F, 0700-1700 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Jessica Harrison can be reached on 703-308-2217. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



M. A. Sager  
Primary Examiner